



**UNITED STATES DEPARTMENT OF COMMERCE**  
**Patent and Trademark Office**

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HL

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/913,976	12/22/97	HODGKINSON	M 71272

HM12/1208

WELSH & KATZ  
120 SOUTH RIVERSIDE PLAZA  
22ND FLOOR  
CHICAGO IL 60606

EXAMINER

PRYOR, A

ART UNIT	PAPER NUMBER
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1616

11

DATE MAILED: 12/08/99

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
**08/913,976**

Applicant(s)  
**Hodgkinson**

Examiner  
**Alton Pryor**

Group Art Unit  
**1616**



☒ Responsive to communication(s) filed on Nov 3, 1999

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 1 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 22-42 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☐ Claim(s) \_\_\_\_\_ is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☒ Claims 22-42 are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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### **New Restriction Requirement**

Upon review of original restriction requirement dated 8/9/99, the First Office Action dated 8/31/99 will be vacated and a new restriction requirement will be set forth as follows:

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 22-35,38-42 drawn to agriculture oils consisting of sulphonate, or phenate, or alkyl amine plus zinc diamyldthio carbamate, or benzoxazole, or benzthiazole, classified in class 504, subclass 116, class 424 subclass 405, class 514 subclass 919.
- II. Claims 36,37 drawn to an additive composition consisting of sulphonate, or phenate, or alkyl amine plus zinc diamyldthio carbamate, or benzoxazole, or benzthiazole, classified in class 252, subclasses 588, 589, class 424 subclass 70.9.

Inventions I and II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the combination does not have to be used as an agricultural composition. The combination can be used as a UV protectant composition. The subcombination has separate utility such as a herbicide, fungicide, etc.

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Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of the recognized divergent subject matter restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

#### **New Election Requirement**

This application contains claims directed to the following patentably distinct species of the claimed invention: Three neutralization adjuvants (sulphonate or phenate or alkyl amine) and Four UV deactivators (zinc diamylldthio or benzoxazole or benotriazole or benzthiazole).

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, a composition consisting of sulphonate or phenate or alkyl amine plus zinc diamylldthio or benzoxazole or benotriazole or benzthiazole is generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations

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of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143). In the applicant's election, **ONE** neutralization adjuvant must be provided <sup>and/or</sup> ~~and~~ **ONE** UV deactivator must be provided.

#### *Telephonic Inquiry*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alton Pryor whose telephone number is (703) 308-4691. The examiner can normally be reached on Monday through Friday from 8:00 a.m. to 4:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jose Dees, can be reached on (703) 308-4628. The fax phone number for this Group is (703) 308-4556.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1235.

ANP

12/3/99



**S. MARK CLARDY**  
**PATENT EXAMINER**  
**GROUP 1200-1616**

*Acting SPT*